

**REMARKS / ARGUMENTS**

Claims 1-17 are pending in this application.

Claims 1-17 were previously deemed allowable per the Notice of Allowance mailed January 27, 2003 pertaining to the present application. Following payment of the Issue Fee, Applicant withdrew the present application from issuance in order to file a Request for Continued Examination and have newly discovered considered in the examination proceedings. The references, which were provided in an Information Disclosure Statement, were cited in the related European case (i.e. EP 01 31 0300) and discovered after payment of the Issue Fee.

In the present case, the Examiner has applied the same art (i.e., Moran et al. (EP 0 997 073)) as applied to the initially filed product by process claims (original claims 18-34) and the process claims 1-17. The product by process claims were cancelled in the Examiner's amendment of January 27, 2003, which accompanied the Notice of Allowance of the same date which indicated that claims 1-17 (the exact claims pending in the present case) were allowable. **The Examiner in the present Office Action has offered no reasoning as to why claims 1-17, which were considered allowable over Moran et al. earlier, are now considered anticipated by this same reference.**

Moreover, Applicant note that claims 1-17 were initially rejected under 35 U.S.C. §103 (but not §102) in the Office Action dated March 15, 2002. Applicants overcame that rejection in their response filed September 20, 2002. **Again the Examiner in the present Office Action has offered no reasoning as to why claims 1-17, which were considered unobvious over Moran et al. earlier, are now considered anticipated by this same reference.**

In the arguments below, Applicants address the single rejection under 35 U.S.C. §102(b) in view of Moran et al. presented in the present Office Action. As noted below, Applicants believe this rejection under is improper and should be withdrawn. In order to expedite prosecution of this application, Applicants also consider the **potential rejection** of claims 1-7 under 35 U.S.C. §103 in view of this same reference. As noted above, this §103 rejection was presented in the Office

Action dated March 15, 2002, and overcome in Applicants' response filed September 20, 2002.

**The Claimed Invention.** The claimed invention provides a method of preparing a cheese product with the texture and consistency of fresh cheese. The cheese product is prepared by:

(1) mixing one or more concentrated powders derived from milk with sodium chloride, milk fat, water, and, optionally, an edible acid and a preservative for a period of time sufficient to produce a mixed product, wherein the concentrated powders are present in an amount ranging from about 25 to about 60 percent, wherein the sodium chloride is present in an amount ranging from about 0.5 to about 4.0 percent, wherein the milk fat is present in an amount ranging from about 9 to about 38 percent, wherein the edible acid is present in an amount ranging from 0 to about 2.0 percent, wherein the preservative is present in an amount ranging from 0 to about 0.2 percent, wherein the water is present at a level sufficient to form the cheese product, wherein percentages are based on the total weight of the cheese product, and wherein the milk fat during mixing is at a temperature of about 80 to about 140°F; and

(2) cooling the mixed product for a time and at a temperature which is sufficient to allow the mixed product to form a solid matrix, wherein the solid matrix is the cheese product;

wherein the cheese product has the texture and consistency of fresh cheese.

**Rejection Under 35 U.S.C. § 102(a)**

Claims 1-17 have been rejected under 35 U.S.C. § 102(a) as being anticipated by Moran et al. (EP 0 997 073 A2). The Examiner asserts that "Moran et al. teach a method for preparing a cheese product comprising mixing a concentrated milk powder, sodium chloride, milk fat, water, and an edible acid at a temperature of 120F," thus anticipating method claims 1-17.

Applicants respectfully submit that the present invention is neither anticipated nor rendered obvious by Moran et al. In order for a reference to anticipate a claim

under 35 U.S.C. § 102(a), the reference **must teach each and every element** of the claim. "A claim is anticipated only if each and every element set forth in the claim is found, either expressly or inherently described, in a single prior art reference." (MPEP Section 2131, quoting *Verdegall Bros. v. Union Oil Co. Of California*, 814 F.2d 628, 631 (Fed. Cir. 1987)). Moran et al. does not teach, or even suggest, each and every element of the claims in question. Specifically, the present claims differ in that the present claims recite a cooling step.

Applicant respectfully points out that the Examiner herself earlier acknowledged that the claims of Moran et al. lack recitation of the cooling step of the present application: **"The claims differ as to the specific recitation of a cooling step to obtain a solid matrix."** Office Action dated March 15, 2002.

The cooling step as recited in claims 1 and 4 of the present application are related to a method for making a cheese product or cheese base, respectively. Furthermore, the cooling step in each of claims 1 and 4 is performed **"for a time and at a temperature which is sufficient to allow the mixed product to form a solid matrix"** and requires that **"the cheese (product or base) has the texture and consistency of fresh cheese."**

Moran et al. teach a process for producing a cheese product directly from milk. The two-stage method taught by Moran et al. involves (1) forming a powdered milk protein concentrate, and (2) converting the powdered milk protein concentrate to the desired cheese product. Nowhere does Moran et al. teach the necessity for a cooling step in relation to the claimed invention. Furthermore, Moran et al. certainly does not explicitly or implicitly teach a **"time and temperature which is sufficient to allow the mixed product to form a solid matrix."** Additionally, Moran et al. does not explicitly or implicitly teach a cooling step resulting in a cheese product and/or cheese base having **"the texture and consistency of fresh cheese."** The difference between the present application and Moran et al. with regard to a **"time and temperature which is sufficient to allow the mixed product to form a solid matrix"** and a cheese product and/or cheese based having **"the texture and consistency of fresh cheese"** is further distinguished insofar as Moran et al. teaches packaging a cheese product after the cheese congeals while the present

application teaches packaging the cheese product and/or cheese base prior to the cooling step. Further, Moran et al. teaches a "cheese product" and not a "cheese base" as is taught in claim 4 of the present application.

Applicants respectfully submit that this rejection is improper and respectfully request that it be withdrawn.

### **Potential 35 U.S.C. §103(a) Rejection**

Although the Examiner did not include a rejection under 35 U.S.C. §103(a) in the present Office Action over Moran et al. (EP 0 997 073 A2), Applicants wish to address such a **potential rejection** in order to expedite prosecution.

The Examiner did present such a rejection<sup>1</sup> in the Office Action dated March 15, 2002, wherein she acknowledged that the claims of Moran et al. and the present claims differ in that the present claims recite a cooling step. The Examiner, however, asserted in that Office Action that it would have been obvious to one of ordinary skill in the art to cool the cooked product of Moran et al.

Applicants assert that whether or not cooling of the Moran et al. product would have been obvious (which it would not) is not relevant to the question of whether the present claims are obvious in view of Moran et al, as the two products are not the same. Nor does the Moran et al. product render the present claims obvious.

To establish a *prima facie* case of obviousness there must be some **suggestion or motivation** in the prior art to make the claimed invention, there must be a **reasonable expectation of success**, and the prior art reference **must teach or suggest all of the claim limitations**. MPEP 2142; *In re Vaeck*, 947 F.2d 488, 20 USPQ2d, 1438 (Fed. Cir. 1991). **Both the suggestion and the expectation of success** must be founded in the prior art, and not in the Applicant's disclosure. *In re Dow Chemical Co.*, 5 USPQ2d 1529 (Fed. Cir. 1988). The mere fact that the prior art can be modified does **not** make the modification obvious unless the prior art **taught or suggested** the desirability of the modification. *In re Gordon*, 221 USPQ

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<sup>1</sup> As also noted earlier, this rejection was overcome in Applicants' response filed September 20, 2002.

1125 (Fed. Cir. 1984). The patent office has the burden of establishing a *prima facie* case of obviousness. MPEP 2142; *In re Vaeck*, 947 F.2d 488, 20 USPQ2d, 1438 (Fed. Cir. 1991).

Claims 1-17 are not rendered obvious by the teachings of Moran et al. Specifically, independent claims 1 and 4, are related to a method for making a cheese product or a process cheese base, respectively. Both of these claims and the claims which depend from them (claims 2, 3, and 4-17) require the following:

(a) mixing the following components:

- (i) one or more concentrated powders derived from milk, present in an amount ranging from about 25 to about 60 percent;
- (ii) sodium chloride, present in an amount ranging from about 0.5 to about 4.0 percent;
- (iii) milk fat, present in an amount ranging from about 9 to about 38 percent;
- (iv) water; and
- (v) optionally, an edible acid, present in an amount ranging from 0 to about 2.0 percent;
- (vi) optionally, a preservative, present in an amount ranging from 0 to about 0.2 percent; and

(b) cooling the mixed product for a time and at a temperature which is sufficient to allow the mixed product to form a solid matrix, wherein the solid matrix is the cheese product.

The second stage of the process disclosed by Moran et al. requires treating the milk protein mixture with shear and cooking the milk protein mixture. Neither one of these steps are recited in claims 1-17. Furthermore, Moran et al. do not teach or even suggest the production of a cheese product without the steps of treating the mixture with shear and subsequently cooking the mixture.

Moreover, it would **NOT** have been obvious to one of ordinary skill in the art to employ the cooling step required in the present invention "for a time and at a temperature which is sufficient to allow the mixed product to form a solid matrix, wherein the solid matrix is the cheese product" and "**wh rein the che se product**

has the texture and consistency of fresh cheese.” The Examiner did indicate that the “cooling of a product to room temperature is conventional and well within the skill of the art, where the solidification of the product is obvious due to the melting point of the product.” This rationale, however, ignores the remainder of the limitation -- the cooling must be done for a time and at a temperature so as to form the solid product wherein the solid product has the **“texture and consistency of fresh cheese.”** It is the total combination of the process steps (including the cooling step) and composition limitations of claims 1 and 4 which allows the simplified production of a solid product having the **“texture and consistency of fresh cheese.”**

The Examiner, other than merely stating her conclusion in the earlier Office Action, has provided no basis or argument in Moran et al. or other prior art as to why one of ordinary skill in the art would cool “the mixed product for a time and at a temperature which is sufficient to allow the mixed product to form a solid matrix, wherein the solid matrix is the cheese product” and **“wherein the cheese product has the texture and consistency of fresh cheese.”** The Examiner has not pointed out in the prior art of record how one of ordinary skill in the art would be lead to such a process or how one of ordinary skill in the art, assuming the prior art suggested such a cooling step (which it does not do), would expect such a cooling step, combined with the remainder of the claimed process, would result in “a solid matrix, wherein the solid matrix is the cheese product” and **“wherein the cheese product has the texture and consistency of fresh cheese.”** Effectively, the Examiner used hindsight reconstruction of the prior art in the earlier Office Action using the Applicants own teachings to arrive at the rejection. As the Examiner knows, the use of such hindsight reconstruction is improper: “To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.” *W. L. Gore & Assoc., Inc. v. Oarlock, Inc.* 220 USPQ 303, 312-13. “One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.” *In re Fine*, 5 USPQ.2d 1596,

1600 (Fed. Cir. 1988). This prohibition against hindsight reconstruction was reaffirmed in *In re Dembicizak*, 50 USPQ.2d 1614 (Fed. Cir.1999):

“Measuring a claimed invention against the standard established by section 103 require the oft-difficult but critical step of casting the mind back to the time of the invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then accepted wisdom in the field. Close adherence to this methodology is especially important in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one ‘to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.’” *In re Dembicizak*, 50 USQ2d at 1617 (citations omitted).

Applicants respectfully submit that this rejection was and is improper and that the Examiner’s earlier allowance of claims 1-17 over Moran et al. was, and remains, proper.

### **Conclusion**


Applicants respectfully submit that the cited reference ***still*** does not render any pending claim unpatentable. The cited reference does not describe or suggest a cooling step that is performed **“for a time and at a temperature which is sufficient to allow the mixed product to form a solid matrix”** or requires that **“the cheese (product or base) has the texture and consistency of fresh cheese.”**

Applicants have clarified the novelty of the present invention. In view of the foregoing remarks, Applicants respectfully request that the Examiner allow the pending claims, and pass this Application to issue. If the Examiner believes that a telephonic or personal interview would be helpful to terminate any issues which may remain in the prosecution of the Application, the Examiner is requested to telephone Applicants' attorney at the telephone number set forth herein below.

The Commissioner is hereby authorized to charge any additional fees which may be required in the Application to Deposit Account No. 06-1135.

Respectfully submitted,

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